

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application into condition for allowance. Applicants acknowledge with appreciation the indication by the Examiner that claims 8, 12, 14, and 21 are allowable.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-21 are now pending.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. 35 U.S.C. § 103 REJECTIONS

Claims 1, 4-5, 9-10, 13 and 15-20 were rejected under 35 U.S.C. §103 as allegedly being rendered unpatentable by U.S. Patent 5,171,389 to Stigberg et al. ("Stigberg") in view of U.S. Patent No. 5,396,755 to Arnold et al. ("Arnold"). Claim 11 was rejected under 35 U.S.C. §103 as allegedly being unpatentable over Stigberg in view of Arnold, further in view of U.S. Patent 5,360,656 to Rexfelt et al. ("Rexfelt"). Claims 1-3, 9-10, 13, and 15-20 were rejected under 35 U.S.C. §103 as allegedly being rendered unpatentable by U.S. Patent 1,651,476 to Sheehan ("Sheehan") in view of Stigberg and Arnold. Claims 6-7 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Sheehan in view of Stigberg, further in view of U.S. Patent 4,446,187 to Eklund et al. ("Eklund"). Claim 11 was rejected under 35 U.S.C. §103 as allegedly

being unpatentable over Sheehan in view of Stigberg and Arnold, further in view of Rexfelt. The rejections will be collectively addressed and respectfully traversed. The cited documents, either alone or in combination fail to teach, suggest, enable, or provide the motivation for a skilled artisan to practice the instantly claimed invention.

The instant invention is directed to a method of manufacturing a press fabric comprising, *inter alia*, attaching a heat-activated adhesive film to one side of a strip of top laminate layer materials to form a multi-component strip; and attaching a side of the strip of top laminate layer material and heat-activated adhesive film at a beginning of the multi-component strip to the outer surface of the base fabric at a point on the first lateral edge of said base fabric using heat and pressure. Stigberg, either alone or in combination, fails to disclose, suggest or motivate to practice the present invention.

Stigberg relates to an impermeable shoe press belt having an impermeable grooved homogenous resin strip on the outer surface of a long nip belt to streamline the production of a grooved belt by rendering unnecessary the steps of coating both sides of the base fabric with an impermeable resin. In contrast, the multicomponent strip of the present invention is permeable and includes a top laminate layer, for example, a woven fabric, a nonwoven mesh, or a sheet of thermoplastic material, and a heat-activated film. Stigberg does not provide a multicomponent strip. Indeed, a preferred embodiment of Stigberg only contains the impermeable resin.

In addition, the Examiner incorrectly equates the heat-activated film of the present invention with the purported adhesive of Stigberg. As mentioned above, Stigberg relates to process belts. As such, polyurethane (from the resin impregnated based fabric) is bonded to polyurethane (the resin of the strip). The only adhesives suggested are polyurethanes. Others

such as low melts would allow delamination of the strip and belt failure. While the polyurethane used as the purported adhesive in Stigberg may be pre-applied, it is nowhere disclosed, suggested or enabled to be in the form of a heat-activated film, as urethane “adhesives” are liquids.

Furthermore, it is known in the art that polyurethane cures over time. Pre-applying a polyurethane, as the alleged adhesive in Stigberg, to a strip and winding up the strip for later use, as described in the present invention, would lead to the polyurethane losing any adhesive potential as a bonding agent because the polyurethane cures over time. In contrast, the present invention’s multicomponent strips are intended to be fabricated, rolled up, then stored until used. Coating a strip with an adhesive that cures over time and rolling it up for storage simply does not make sense and is impractical. Thus, the use of the heat-activated film has a distinct advantage over the use of the alleged adhesive provided in Stigberg.

Arnold does not remedy the deficiencies in Stigberg. First, Arnold relates to hay conditioning with a reinforced roll cover and not to a method of manufacturing a press fabric. Accordingly, there is no motivation to combine the reference teaching with that of Stigberg. Second, the Examiner relies on Arnold solely that it allegedly suggests bonding under pressure. (*Office Action*, at 3). The rejections based on the additional reference to Arnold should be withdrawn in view of the foregoing discussion as Arnold does not disclose, teach or suggest a multicomponent strip or a heat-activated adhesive.

Further, Arnold does not disclose, suggest or teach bonding under pressure to ensure that a top laminate layer becomes attached to a base fabric by means of a heat-activated adhesive. Arnold relates to a roll cover comprising one or more layers of plies of reinforcing material interspersed between and bonded to layers of newly extruded elastomer. Bonding agents are

preferably employed to bond the plies and layers together, and the resulting assemblies are vulcanized. Actually, the bonding occurs because the extruded strip of elastomer, which is typically hot and tacky, allows it to adhere to the woven reinforcing material while both are applied to a common roll core. The reinforcing material may contain an adhesive coating, such as resorcinol formaldehyde latex for thermoplastic fibers or silane for fiberglass fibers, to promote bonding of the reinforcing material to the elastomer. In this context, resorcinol formaldehyde and silane are adhesion promoters, such as are used in tire cord and polyurethane coated yarns. They are not adhesives. Moreover, the purpose of pressure is to mesh the reinforcing material into the tacky elastomer and not to ensure that a top laminate layer becomes attached to a base fabric by means of a heat-activated adhesive.

Accordingly, Arnold does not disclose, suggest or teach a multicomponent strip of the present invention that is permeable and includes a top laminate layer; or a heat-activated film; or bonding under pressure to ensure that a top laminate layer becomes attached to a base fabric by means of the heat-activated adhesive. Consequently, reconsideration and withdrawal of the above Section 103 rejection is believed to be in order and such actions are respectfully requested.

Claim 11 was rejected under 35 U.S.C. §103 as allegedly being unpatentable over Stigberg in view of Arnold, further in view of Rexfelt. Rexfelt does not remedy the deficiencies in Stigberg and Arnold. Rexfelt is relied upon solely that it allegedly suggests wrapping material from a roll where rolls are a convenient means for storing material till use. (*Office Action* at 4). The rejections based on the additional reference to Rexfelt should be withdrawn in view of the foregoing discussion.

Claims 1-3, 9-10, 13, and 15-20 were rejected under 35 U.S.C. §103 as allegedly being rendered unpatentable by Sheehan in view of Stigberg and Arnold. Sheehan is equally defective and does not remedy the deficiencies in Stigberg and Arnold. Sheehan relates to a web carrier for papermaking machines. The Examiner relies upon Sheehan as it allegedly suggests a press fabric endless loop for a paper machine including an adhesive between a base fabric and a top laminate layer, where the adhesive is not limited to rubber cement but can be any other suitable adhesive not soluble in water. (*Office Action*, at 4). Sheehan fails to disclose, suggest or teach, *inter alia*, a multi-component strip or a heated-activated adhesive.

First, one of ordinary skill in the art would understand the felts (web carriers) disclosed in Sheehan in 1925 (the date of the purported invention) were woven from spun yarns and usually made predominately of wool. The felts were filled, washed napped, singed and often treated. Napping attempts to obtain a smooth “working” (sheet contact) surface. At the time of Sheehan, wool fibers came in various grades, and for early positions, were usually of the finest (both fine in terms of size and fines in terms of quality) grade. In Sheehan, layer F is carded wool, felted wool, or a wool fabric, and is attached to fabric B by means of a purported water insoluble adhesive to form a laminate. Rubber cement is used as the purported adhesive to bond a layer of “fiber” (a lower quality than a “felt”) to fabric B. Layer F, pounded wool, is not a mesh as used in the today’s context of woven or nonwoven. As such, the layer described in Sheehan is not a multicomponent strip of the present invention.

In addition, Sheehan does not teach or suggest a heat-activated adhesive. Indeed, when the alleged adhesive is used, it is laid onto the base fabric. It is well known that rubber cement is a liquid. The sheet in Sheehan is simply a continuous layer of liquid cement. Accordingly,

“other water insoluble adhesives” do not describe or suggest the new technology of heat-activated adhesive films. Thus, the rejections based on the additional reference to Sheehan should be withdrawn in view of the foregoing discussion.

Claims 6-7 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Sheehan in view of Stigberg, further in view Eklund. Eklund does not remedy the deficiencies in Sheehan and Stigberg in that Eklund is relied upon solely that it allegedly suggests that in order to ensure maximum dewatering evenness in the papermaking process, it is necessary to provide a high degree of controlled porosity. (*Office Action* at 6). The rejections based on the additional reference to Eklund should be withdrawn in view of the foregoing discussion.

Claim 11 was rejected under 35 U.S.C. §103 as allegedly being unpatentable over Sheehan in view of Stigberg and Arnold, further in view of Rexfelt. Rexfelt does not remedy the deficiencies in Sheehan, Stigberg and Arnold. The rejections based on the additional reference to Rexfelt should be withdrawn in view of the foregoing discussion.

In order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference’s teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed

invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, the cited document fails to teach, suggest or disclose the instantly claimed invention.

It is well-settled that picking and choosing portions from three disparate references in order to formulate an obviousness rejection is impermissible. Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. *See In re Fine*. And as "obvious to try" would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

Consequently, reconsideration and withdrawal of the Section 103 rejections are believed to be in order and such actions are respectfully requested.

III OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

Claims 1-21 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-20 of U.S. Patent No. 6,350,336 ("the '336 patent"). Although Applicants disagree with the Examiner's allegations, submission of a terminal disclaimer is respectfully deferred until an indication of allowed subject matter, and whether such is necessary in view of the claims allowed.

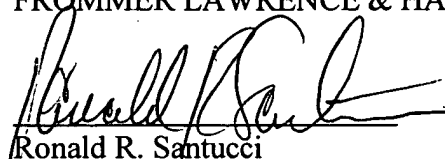
No additional fees are deemed to be required for the filing of this response, but if such are, the Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 50-0320.

CONCLUSION

By this response, the instant claims should be allowed; and this application is in condition for allowance. Favorable reconsideration of the application and withdrawal of the rejections are therefore earnestly solicited.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:



Ronald R. Santucci

Reg. No. 28,988

Tel: (212) 588-0800

Fax: (212) 588-0500